REMARKS

This Request for Substitute Office Action is made in reply to the Office Action dated January 21, 2010, in which the Examiner:

objected to the drawings;

objected to the Abstract;

rejected claims 20-25 and 28-34 under 35 U.S.C. § 112, second paragraph, as indefinite;

rejected claims 20-25 and 28-34 under 35 U.S.C. § 102(a) as anticipated by German Utility Model No. DE 202 08 106 U1 by Danfoss Silicon Power GmbH ("the German Utility Model"); and

rejected claims 20-25 and 28-34 under 35 U.S.C. § 102(d) as anticipated by the German Utility Model.

Applicants submit the following remarks in support of their Request for Substitute Office Action, in accordance with M.P.E.P. § 710.06. In the subject application, claims 20-35 are pending. Claims 26, 27 and 35 were withdrawn in response to a Restriction/Election Requirement. Claim 20 is the lone independent claim.

As is well known, 35 U.S.C. § 132(a) sets forth the mandatory requirements for any Office Action that rejects or objects to any claims in an application for letters patent:

> Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined.

Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. § 102(a) and 35 U.S.C. § 102(d) set forth in the outstanding Office Action fall far short of the statutory mandates of 35 U.S.C. § 132(a), as the Examiner has failed to provide Applicant with "the reasons for such rejection, together with

such information and references as may be useful in judging the propriety of continuing the prosecution of his application." As a result, Applicant is unable to prepare an appropriate response thereto.

Specifically, Applicant maintains that the Examiner's one-sentence anticipation rejections of the thirteen active claims pending in the subject application, *i.e.*, "[the German Utility Model] discloses the fluid-coolable unit essentially as claimed," and "claims 20 through 25 and 28 through 34 are rejected under 35 U.S.C. § 102(d) as being barred by [the German Utility Model], which was filed on May 24, 2002, in Germany, which is more than twelve months before the filing of the instant application in the United States," *see* Office Action, pages 4-5, fail to demonstrate that each and every element recited in claims 20-25 and 28-34 is shown or disclosed in as complete detail as is contained in the claim, with its elements arranged as required by the claim. *See* M.P.E.P. § 2131. Moreover, the Examiner has expressly failed to satisfy the four requirements of 35 U.S.C. § 102(d), particularly that claims 20-25 and 28-34 could have been presented in the German Utility Model. *See* M.P.E.P. § 2135.01.

Furthermore, when the Examiner cites a reference that is in a language other than English, and seeks to rely on that reference in rejecting a claim, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. *See* M.P.E.P. § 706.02. The Office Action is not accompanied by <u>any</u> translation of the German Utility Model, and the record is not clear as to which facts, if any, were relied upon by the Examiner in rejecting claims 20-25 and 28-34 as anticipated.

Because 35 U.S.C. § 132(a) provides the minimum procedural standard for patent examination, Applicants submits that the Examiner's failure to meet the requirements of 35 U.S.C. § 132(a) renders the present Office Action arbitrary and capricious under the Administrative Procedure Act, 5 U.S.C. § 706(2)(A). Additionally, Applicant further submits that the Examiner's failure to meet the requirements of 35 U.S.C. § 132(a) renders the present Office Action *ultra vires* for exceeding the expressly limited statutory authority of the United States Patent & Trademark Office.

Section 710.06 of the Manual of Patent Examining Procedure provides that when an Office Action contains some error that affects Applicant's ability to reply

to the Office Action, and this error is called to the attention of the Office within one (1) month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected. The present Office Action was mailed on January 21, 2010, and this Request is made on February 19, 2010.

Accordingly, for at least the foregoing reasons, Applicant respectfully requests that the present Office Action be withdrawn, that a proper non-final Office Action be issued, and that a new three (3) month period for response be set from the mailing date of the proper non-final Office Action, as provided by M.P.E.P. § 710.06.

As the deficiencies addressed herein render the present Office Action ineffective under 35 U.S.C. § 132(a), and as the present communication relates to a remedy available as-of-right under the express guidance of M.P.E.P. § 710.06, Applicant does not consider the present communication as a petition, and does not believe any fee should be payable. However, should the Commissioner disagree, Attorneys for Applicant hereby authorize the Commissioner to deduct the appropriate fee for a petition invoking the Director's supervisory authority.

Applicant believes no fees are due in connection with this Request. If additional fees are deemed necessary, Attorneys for Applicant hereby authorize the Commissioner to deduct such fees from our Deposit Account 13-0235.

Respectfully submitted

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